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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,980	03/20/2001	In Ho Choi	2080-3-09	1464

35884 7590 09/29/2004

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,980

Applicant(s)

CHOI, IN HO

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION***Specification***

1. The disclosure is objected to because elements 504 & 507 on figure 5 have been described/labeled interchangeably throughout pages 12-14 (second embodiment of the invention) as "tangential coil" and "focusing coil", respectively, which should have been --focusing coil-- and --tangential coil--, respectively. The specification and the claims do not appear to show any evidence that the applicant intends these two elements to be switched. Therefore, this has been perceived as typographical errors, and the specification is objected to due to the following minor informalities:

Page 12, line 23: "tangential coil 504" should be --tangential coil 507--.

Page 12, line 24: "focusing coil 507" should be --focusing coil 504--.

Page 13, line 4: "tangential coil" should be --focusing coil--.

Page 13, lines 6, 23 & 25; page 14, line 3: "focusing" should be --tangential--.

Page 14, line 5: "tangential" should be --focusing--.

Page 14, line 8: "tangential tilting" should be --focusing--.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-11 & 15-19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which were not described in the specification in such a way as to enable one skilled in the art to

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which they pertain, or with which they are most nearly connected, to make and/or use the invention.

In regard to claim 1, there is no disclosure of how to make and use an actuator having a fixed body attached with a pair of first magnets and a coil serving to move the lens holder in a desired direction. It is not described how a magnet and a coil both attached to the same fixed body cause movement.

In regard to claim 9, there is no disclosure of how to make and use an actuator having a moving magnet system to conduct tracking and focusing operations and a moving coil system to conduct a tilt compensating operation.

In regard to claim 15, there is no disclosure of how to make and use an actuator having the claimed alternative operating condition of driving a second magnetic circuit unit for tilting operations when a first magnetic circuit unit is driven for tracking and focusing operations, and driving the second magnetic circuit unit for tracking and focusing operations when the first magnetic circuit unit is driven for tilting operations. This configuration appears to require switchable circuits, which are not shown in the specification. Furthermore, there is no disclosure of a moving coil system for radial and tangential tilt compensation and a moving magnet for tracking and focusing operations.

Claims 2-8, 10, 11 & 16-19 are rejected because these claims are dependent upon rejected base claims.

Response to Amendment

4. The amendment filed on June 10, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added

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material which is not supported by the original disclosure is as follows: see second thru fourth paragraphs on page 2; and first thru last paragraphs on page 3 of the amendment.

For the second embodiment of the invention, the original specification discloses a moving coil system for tracking/focusing operations and a moving magnet system for radial/tangential tilting (see page 13, paragraph 3), which is exactly the same as that of the first embodiment. In addition, page 13, paragraph 4 specifically points out that the second embodiment is different from that of the first embodiment because the lens holder also serves as the second magnet. This led the examiner to believe that, except for the magnetic lens holder, the rest of the features of the second embodiment are no different from those of the first embodiment. In addition, the examiner would like to point out that the errors to the specification objected to on the previous Office Action has made it even more difficult for the examiner to formulate an assumption to what the applicant intends to disclose (see paragraph 1 of this Office Action).

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

5. Regarding the objections to the specification, the applicant requests that the objections be withdrawn because elements 504 and 507 no longer appear to be switched as a result of the newly amended disclosure. However, the changes made by the applicant constitute new matter, as noted above. Therefore, the objections will not be withdrawn.

6. In regard to claim 1, the applicant submits that the specification sufficiently discloses what is claimed. The examiner disagrees. Applicant should note that the coils 304 & 305 and the magnets 303 are all attached to the yoke 306. The specification does

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refer to the first magnets being driven, but does not disclose the first magnets being driven with respect to something, e.g., an interlinkage between elements.

7. In regard to claim 9, the changes made by the applicant to overcome the rejection constitute new matter, as noted above. Therefore, the argument is now moot.

8. In regard to claims 13 & 14, the amendment to the claims has put these claims in condition for allowance.

9. In regard to claim 15, the changes made by the applicant to overcome the rejection constitute new matter, as noted above. Therefore, the argument is now moot.

In addition, the applicant argues that one skilled in the art would be able to implement the tracking/focusing/radial tilt/tangential tilt systems onto one optical pick-up actuator without undue experimentation; and that the disclosure does not need to teach the “switchable circuits”. The examiner disagrees. It is not a question of what one “would” be able to do, rather, it is a question of what is disclosed. Switchable circuits are not well-known details of a particular component, rather, they are a critical component to enable the claimed invention. Details that are to be omitted are well-known details of components, such as the particular materials in the magnets/coils. The details of a particular switch might be omitted, but there must be a suggestion to use a switch for such to be a part of the invention.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin
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September 14, 2004


ALLEN CAO
PRIMARY EXAMINER